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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Kentaro Yano

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EXAMINER

PACHOL, NICHOLAS C

ART UNIT

PAPER NUMBER

2625

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/567,160	<b>Applicant(s)</b> YANO ET AL.	
	<b>Examiner</b> Nicholas C. Pachol	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37,38 and 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37,38 and 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 47 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 47 now recites the limitation "... in a case that it is determined in the determining step that the plurality of images...". However, "the determining step" is not previously mentioned in the claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 37, 38, 41, 42, and 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima (US 2001/0048802) in view of Obrador (US 2002/0186383).

Regarding Claim 37, Nakajima '802 teaches a recording apparatus for recording an image on a recording medium (Figure 1, element 13 and Page 4, paragraph 62) based on image data supplied from an image supply device (Page 1, paragraph 8), comprising:

a reception unit that receives a layout condition from the image supply device, wherein the layout condition specifies a layout for recording a plurality of items of image data on a recording medium, which are supplied from the image supply device (Page 1, paragraph 14).

Nakajima '802 does not teach a determination unit that determines whether or not a plurality of items of image data supplied from the image supply device includes a predetermined format of image data; and

a control unit that controls the recording apparatus to record the plurality of items of image data supplied from the image supply device without overlapping with another

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image data in accordance with the layout condition in a case that the determination unit determines that the plurality of items of image data do not include the predetermined format of image data, and controls the recording apparatus to record the plurality of items of image data supplied from the image supply device by overlapping with another image data in accordance with the layout condition in a case that the determination unit determines that the plurality of items of image data include the predetermined format of image data.

Obrador does teach a determination unit that determines whether or not a plurality of items of image data supplied from the image supply device includes a predetermined format of image data (Page 2, paragraphs 23 and 24); and

a control unit that controls the recording apparatus to record the plurality of items of image data supplied from the image supply device without overlapping with another image data in accordance with the layout condition in a case that the determination unit determines that the plurality of items of image data do not include the predetermined format of image data, and controls the recording apparatus to record the plurality of items of image data supplied from the image supply device by overlapping with another image data in accordance with the layout condition in a case that the determination unit determines that the plurality of items of image data include the predetermined format of image data (Page 2, paragraphs 23 and 24).

Nakajima '802 and Obrador are combinable because they both teach printing images from a camera.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Nakajima '802 with the teachings of Obrador for the purpose of properly printing the overlay without lags in processing (Obrador: Page 1, paragraph 12).

Regarding Claim 38, Nakajima '802 further teaches wherein the predetermined format of image data designates an image to be seen through with another image (Page 2, paragraph 29 and Page 5, paragraph 75).

Regarding Claim 41, Nakajima '802 teaches a recording apparatus for recording an image on a recording medium (Figure 1, element 13 and Page 4, paragraph 62) based on image data supplied from an image supply device (Page 1, paragraph 8), comprising:

a reception unit that receives a layout command for specifying a layout of recording a plurality of images on a recording medium and designation data for designating a plurality of images to be recorded, from the image supply device (Page 1, paragraph 14).

Nakajima '802 does not teach a determination unit that determines whether or not the plurality of images designated by the designation data have a predetermined format; and

a control unit that control the recording apparatus to record an image without overlapping with another image in accordance with the layout command, in a case that

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the determination unit determines that the plurality of images do not have the predetermined format, and controls the recording apparatus to record a specific image having the predetermined format by overlapping with another image in accordance with the layout command in a case that the determination unit determines that the plurality of images have the predetermined format.

Obrador does teach a determination unit that determines whether or not the plurality of images designated by the designation data have a predetermined format (Page 2, paragraphs 23 and 24); and

a control unit that control the recording apparatus to record an image without overlapping with another image in accordance with the layout command, in a case that the determination unit determines that the plurality of images do not have the predetermined format, and controls the recording apparatus to record a specific image having the predetermined format by overlapping with another image in accordance with the layout command in a case that the determination unit determines that the plurality of images have the predetermined format (Page 2, paragraphs 23 and 24).

Nakajima '802 and Obrador are combinable because they both teach printing images from a camera.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Nakajima '802 with the teachings of Obrador for the purpose of properly printing the overlay without lags in processing (Obrador: Page 1, paragraph 12).

Regarding Claim 42, Nakajima '802 further teaches wherein the specific image is an image to be seen through another image (Page 2, paragraph 29 and Page 5, paragraph 75).

Regarding Claim 44, Nakajima '802 further teaches wherein the specific image has a predetermined file name or arranged in a predetermined folder (Page 2, paragraph 29).

Regarding Claim 45, Nakajima '802 further teaches further comprising a setting unit that sets an order of overlapping images in accordance with an order of designation of images among the images designated by the designation data (Page 5, paragraph 75).

Regarding Claim 46, Nakajima '802 teaches a recording method (Page 1, paragraph 2) of recording an image on a recording medium (Figure 1, element 13) based on image data supplied from an image supply device (Page 1, paragraph 8), comprising the steps of:

receiving a layout condition from the image supply device, wherein the layout condition specifies a layout of recording a plurality of items of image data on a recording medium, which are supplied from the image supply device (Page 1, paragraph 14).



Nakajima '802 does not teach determining whether or not the plurality of items of image data supplied from the image supply device include a predetermined format of image data; and

recording the plurality of items of image data supplied from the image supply device without overlapping with another image data in accordance with the layout condition in a case that it is determined in the determining step that the plurality of items of image data do not include the predetermined format of image data, and recording the plurality of items of image data supplied from the image supply device by overlapping with another image data in accordance with the layout condition in a case that it is determined in the determining step that the plurality of items of image data include the predetermined format of image data.

Obrador does teach determining whether or not the plurality of items of image data supplied from the image supply device include a predetermined format of image data (Page 2, paragraphs 23 and 24); and

recording the plurality of items of image data supplied from the image supply device without overlapping with another image data in accordance with the layout condition in a case that it is determined in the determining step that the plurality of items of image data do not include the predetermined format of image data, and recording the plurality of items of image data supplied from the image supply device by overlapping with another image data in accordance with the layout condition in a case that it is determined in the determining step that the plurality of items of image data include the predetermined format of image data (Page 2, paragraphs 23 and 24).

Nakajima '802 and Obrador are combinable because they both teach printing images from a camera.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Nakajima '802 with the teachings of Obrador for the purpose of properly printing the overlay without lags in processing (Obrador: Page 1, paragraph 12).

Regarding Claim 47, Nakajima '802 teaches a recording method (Page 1, paragraph 2) of recording an image on a recording medium (Figure 1, element 13 and Page 4, paragraph 62) based on image data supplied from an image supply device (Page 1, paragraph 8), comprising the steps of:

receiving a layout command for specifying a layout of recording a plurality of images on a recording medium and designation data for designating a plurality of images to be recorded, from the image supply device (Page 1, paragraph 14).

Nakajima '802 does not teach recording an image without overlapping with another image in accordance with the layout command, in a case that it is determined in the determining step that the plurality of images do not have the predetermined format, and recording a specific image having the predetermined format by overlapping with another image in accordance with the layout command in a case that it is determined in the determining step that the plurality of images have the predetermined format.

Obrador does teach recording an image without overlapping with another image in accordance with the layout command, in a case that it is determined in the

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determining step that the plurality of images do not have the predetermined format, and recording a specific image having the predetermined format by overlapping with another image in accordance with the layout command in a case that it is determined in the determining step that the plurality of images have the predetermined format (Page 2, paragraphs 23 and 24).

Nakajima '802 and Obrador are combinable because they both teach printing images from a camera.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Nakajima '802 with the teachings of Obrador for the purpose of properly printing the overlay without lags in processing (Obrador: Page 1, paragraph 12).

Regarding Claim 48, Nakajima '802 further teaches a computer readable recording medium characterized by storing a program for causing a computer to execute a recording method according to claim 46 (Page 1, paragraph 2).

Regarding Claim 49, Nakajima '802 further teaches a computer readable recording medium characterized by storing a program for causing a computer to execute a recording method according to claim 47 (Page 1, paragraph 2).

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7. Claims 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakajima (US 2001/0048802) in view of Obrador (US 2002/0186383) further in view of Nakajima (US 2004/0012821).

Regarding Claim 40, Nakajima '802 in view of Obrador does not teach wherein the predetermined format of image data or other than JPEG.

Nakajima '821 does teach wherein any one of the formats includes JPEG or other than JPEG (Page 5, paragraph 97).

Nakajima '802 and Nakajima '821 are combinable because they both teach transferring images from a camera to a printer for printing.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Nakajima '802 in view of Obrador with the teachings of Nakajima '821 for the purpose of being able to use any compatible format (Nakajima '821: Page 5, paragraph 97).

Regarding Claim 43, Nakajima '802 in view of Obrador does not teach wherein the specific image has a predetermined format of image other than JPEG.

Nakajima '821 does teach wherein the specific image has a predetermined format of image other than JPEG (Page 5, paragraph 97).

Nakajima '802 and Nakajima '821 are combinable because they both teach transferring images from a camera to a printer for printing.

Therefore it would have been obvious for one of ordinary skill in the art at the time the invention was made to combine the teachings of Nakajima '802 in view of Obrador with the teachings of Nakajima '821 for the purpose of being able to use any compatible format (Nakajima '821: Page 5, paragraph 97).

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-Thr, 8:00 a.m.- 4:00 p.m. (EST), Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C. P./  
Examiner, Art Unit 2625

03/03/10

/Twyler L. Haskins/  
Supervisory Patent Examiner, Art Unit 2625